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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,368	11/10/2000	Michael Dean Whitmarsh	10003975-1	5508

22879 7590 06/29/2005

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 FORT COLLINS, CO 80527-2400

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/710,368	Applicant(s) WHITMARSH ET AL.	
	Examiner Thierry L. Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-11,13-20 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-11,13-20 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

- This action is responsive to the following communication: RCE filed on 4/18/05.
- Claims 1-6, 9-11, 13-20, 23-25 are pending in application; Claims 7-8, 12, 21-22, and 26 have been canceled.
- Amendment After Final filed on 2/14/05 has been entered.

### ***Claim Objections***

Claims 1 & 14 objected to because of the following informalities: The examiner recommends deleting “based on the image” as cited in both claims 1 & 14. Since determining an appropriate application is based upon three factors including image characteristics, specified print parameters, and specified application. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 & 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unclear whether “specified application” and “appropriate application” are the same or different. Herein, the examiner interprets “specified application” is the same as “appropriate application”. Please refer to page 8, lines 23-31 of the original filed specification for more details. The examiner recommends the applicants to clarify the difference between “specified application” and “appropriate application” to reflect its distinctiveness, please refer to pages 8-9 for more details.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9-11, 13-20, 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al (U.S. 2003/0140315).

Regarding claim 1, Blumberg discloses a method of processing an image (*on-demand print server processes the image before sending to the print provider, pars. 9-15, page 1*) before printing of the image by a print provider, the method comprising the steps of:

- (●) defining a print processing system controller (*on-demand print server, fig. 3*) having a network communication link (*Internet network, fig. 3*);
- (●) receiving at the print processing system controller a print request (*i.e. document/image print order requests with finishing options, fig. 6, pars. 9-15, page 1 and pars. 28-34, page 2*) and a data file (*i.e. finishing options such as colors selection for print orders/requests, pars. 28-29, page 2*) for the image via the network communication link; and
- (●) determining an appropriate application (*i.e. determining and selecting the type of output product such as business card, poster, and etc. for print orders, pars. 28-29, page 2*) for the image with the print processing system controller based on the image, including processing the print request and the data file for the image to determine the appropriate application (*i.e. the server determines which applications such as print media, color and etc that is appropriate for the image, pars. 142-147*) for the image by the print processing system controller (*on-demand print server receives a print order (images/documents printing) with finishing options selected by the users/customers and then on-demand print server determines which print provider most compatible for servicing/printing the print order as requested, figs. 2-6, pars. 9-15, page 1 and pars. 28-34, page 2, and pars. 142-147, page 7*) to determine an image characteristic including at least one of a print resolution, a bit depth, a size, a file size, and a quality of the image (*image quality, par. 138*) and determine one of a specified application (*determining what document type is selected, for example, i.e. business card, par. 78*) and a specified printing option (*printing options, par. 72*) including at least one of a print medium size and a print medium type for the image, and including comparing (*print server displaying a view of a virtual*

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*representation of a document (i.e. business card) based upon a specified application (i.e. business card), selected printing options, and image quality for comparing purposes, par. 145)*

the image characteristic and the one of the specified application and the specified printing option to determine the appropriate application (*i.e. the server determines which applications such business card, poster, and etc. is selected for inputted image, par. 29*) for the image.

*Please notes: the examiner herein interprets "specified application" is the same as "appropriate application".*

Regarding claim 2, Blumberg further discloses the method of claim 1, wherein the network communication link includes an Internet communication link (Internet communication network, fig. 3).

Regarding claim 3, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between a customer and the print processing system controller, and wherein receiving the print request and the data file for the image includes receiving the print request and the data file (image data with selected parameters, pars. 28-34, page 2) for the image from the customer via the network communication link.

Regarding claim 4, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between a customer and the print processing system controller (fig. 3, pars. 148-154, page 7); and reporting the appropriate application (pars. 28-34, page 2) for the image to the customer via the network communication link.

Regarding claim 5, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between the print provider and the print processing system controller (fig. 3), and wherein the step of receiving the print request and the data file for the image includes receiving the print request and the data file for the image (i.e. finishing options, pars. 28-34, page 2) from the print provider via the network communication link.

Regarding claim 6, Blumberg further discloses the method of claim 1, further comprising: defining the network communication link between the print processing system controller (communication network, fig. 3) and at least one of a content provider (print provider, par. 34, pages 2-3) offering a plurality of images (pre-defined templates, pars. 28-44, pages 2-3) and an application provider offering an application for the image, and wherein the step of receiving the print request and the data file for the image includes receiving the print request and the data file for the image from the at least one of the content provider (pars. 28-44, pages 2-3) and the application provider via the network communication link.

Regarding claim 9, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes receiving a request for a plurality of appropriate applications (media type and size, par. 28-34, page 2) for the image.

Regarding claim 10, Blumberg further discloses the method of claim 1, wherein determining the appropriate application for the image includes determining an appropriate print medium size for the image (media type and size, par. 28-34, page 2).

Regarding claim 11, Blumberg further discloses the method of claim 1, wherein determining the appropriate application for the image includes determining an appropriate quality (i.e. colors finishing options, pars. 28-34, page 2) for the image.

Regarding claim 13, Blumberg further discloses the method of claim 1, wherein receiving the print request and the data file for the image includes specifying at least one of a print medium size and a print medium type for the image (media type and size, pars. 28-34, page 2), and wherein the step of determining the appropriate application for the image further includes determining whether the at least one of the print medium size and the print medium type (media type and size, pars. 28-34, page 2) is appropriate for the image.

Regarding claims 14-20, 23-25 recite limitations that are similar and in the same scope of invention as to those in claims 1-6, 9-11, and 13 above; therefore, claims 14-20, 23-25 are rejected for the same rejection rationale/basis as described in claims 1-6, 9-11, and 13.

### *Response to Arguments*

Applicant's arguments, see page 8, filed 2/14/05, with respect to the rejection(s) of claim(s) 1 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretations of previous applied prior art (US 2003/0140315) due to amended claims 1 & 14.

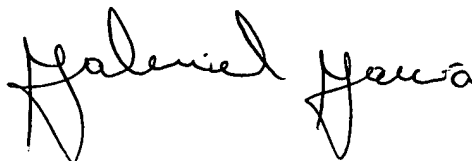
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER